

## REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on November 15, 2006. A petition for a one month extension of time is submitted herewith. The Director is authorized to charge \$120.00 for the petition of time and any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-568 on the account statement.

Claims 1-20 are pending in this application. In the Office Action, Claims 1-19 are objected to, Claims 9-11 are rejected under 35 U.S.C. §112, second paragraph, and Claims 1-20 are rejected under 35 U.S.C. §103. In response Claims 1, 9-11 and 20 have been amended. This amendment does not add new matter. In view of the amendment and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

Claims 1-19 are objected to because of informalities. In response, Applicants have amended Claims 1 and 9-10 to address the informalities cited by the Patent Office. Accordingly, Applicants respectfully request that the objection to Claims 1-19 be withdrawn.

In the Office Action, Claims 9-11 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response, Applicants have amended Claims 9-11 to change "water-soluble powder" to "water-soluble material," which has an antecedent basis in Claim 1. Based on at least these noted reasons, Applicants believe that Claims 9-11 fully comply with 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request that the rejection of Claims 9-11 under 35 U.S.C. §112 be withdrawn.

In the Office Action, Claims 1-16 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over GB 2027662 to Marek ("*Marek*"). Claims 17-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Marek* in view of U.S. Patent No. 6,777,007 to Cai ("*Cai*"). Applicants respectfully disagree with and traverse these rejections for at least the reasons set forth below.

Independent Claims 1 and 20 recite, in part, a package comprising a water-soluble beverage material in an amount sufficient to form the beverage and a filler. The water-soluble material can comprise, for example, soluble coffee powder, milk powder, a creamer substitute

powder, chocolate powder and mixtures thereof. See, specification, page 5, lines 18-19. The filler comprises a water insoluble material. The filler is used to maintain the proper volume and size of the package and prevent collapsing in the extraction chamber. In contrast, Applicants respectfully submit that *Marek* fails to disclose or suggest every element of the present claims.

*Marek* fails to disclose or suggest a water-soluble beverage material in an amount sufficient to form the beverage as required, in part, by the present claims. For example, *Marek* is said to disclose a filter package comprising ground coffee and a neutral anti-agglomerating material. The anti-agglomerating material prevents the ground coffee from agglomerating during brewing. Nevertheless, *Marek* fails to disclose or suggest a package comprising a water-soluble beverage material because ground coffee is a water insoluble material. In fact, Applicants' specification teaches that the filler (e.g. the water insoluble material) can comprise cellulose, fiber, fresh or spent ground coffee and combinations thereof.

In addition, the filler of the present claims has several functions: 1) improving the foam generation, and 2) avoiding collapsing of the package when the water-soluble material has left the filter package. In contrast, *Marek* teaches that the function of the anti-agglomerating material is to prevent or reduce contact between the grains of ground coffee, which results in agglomeration when the coffee bag is soaked in hot water (e.g. similar to tea bags).

In contrast to the coffee bag of *Marek*, the beverage portioned package of the present claims is designed and constructed to be brewed by water being injected under pressure. Applicants believe that it has not been possible to efficiently brew soluble material in this manner, e.g., soluble coffee powder, because the beverage portioned package unavoidably collapses in the brewing machine resulting in poor pressure within the package and a beverage having a very poor taste and quality. Furthermore, the amount of soluble powder needed for a cup of coffee in a beverage portioned package is relatively low. As a result, the present invention proposes a solution where water soluble material can be effectively brewed in beverage portioned packages and dispensed therefrom into a container.

Finally, Applicants respectfully submit that there is no suggestion or motivation to combine the *Marek* and *Cai* to arrive at Claims 17-19 because each reference is directed to devices having entirely different modes of operation. For example, *Marek* is directed to a coffee bag that can be dipped in hot water similar to a bag of tea. On the other hand, *Cai* is directed to a pod designed to work with a beverage extraction device. The pod's construction is sturdy

enough to withstand high pressure injection and extraction of a fluid into and out of the pod. The Patent Office has provides no evidence that the coffee bag of *Marek* is capable of withstanding the high pressure injections and extractions of fluids from a beverage extraction device or is even capable of working in this manner. Consequently, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

For at least the reasons discussed above, Applicants respectfully submit that *Marek* fails to disclose or suggest every element of Claims 1 and 20 and Claims 2-16 that depend from Claim 1. Moreover, Applicants respectfully submit that the combination of *Marek* and *Cai* is improper and therefore does not render Claims 17-19 obvious in view of same.

Accordingly, Applicants respectfully request that the rejections of Claims 1-20 under 35 U.S.C. §103 be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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